

37 C.F.R. § 1.8 Certificate of Mailing:

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid in an envelope addressed to: Office of the General Counsel, United States Patent and Trademark Office, P.O. Box 15667, Arlington, VA 22215

Michelle Brownlee

(Signature)

Michelle Brownlee

(Name)

August 1, 2005

(Date)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial No. 75/662,006
For the Trademark ORALMAX & Design
Published in the Official Gazette on August 28, 2001

GILLETTE CANADA COMPANY, dba
ORAL-B LABORATORIES,

Opposer,

v.

ROBIN RESEARCH LABORATORIES,

Applicant.

Opposition No. 91124984

Office of the General Counsel
United States Patent and Trademark Office
P.O. Box 15667
Arlington, VA 22215

**OPPOSER'S NOTICE OF APPEAL TO THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA**

Notice is hereby given that Opposer, Gillette Canada Company dba Oral-B Laboratories ("Opposer"), appeals from the decision of the Trademark Trial and Appeal Board, which was mailed April 12, 2005, the appeal being to the United States District Court for the District of

Columbia pursuant to 15 U.S.C. § 1071(b). Opposer made a Motion for Reconsideration of the Decision, and the Board issued a decision denying the motion on June 3, 2005. Copies of both decisions are attached as Exhibits A and B hereto.

Dated: August 1, 2005

**GILLETTE CANADA COMPANY, DBA
ORAL-B LABORATORIES**



Michelle Brownlee, Esq.
The Gillette Company
Prudential Tower Building
Boston, MA 02199
(617) 421-7855

Attorneys for Opposer, Gillette Canada
Company dba Oral-B Laboratories

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Opposer's Notice of Appeal is being served by first class mail, postage prepaid, upon the Applicant's attorney of record:

David Ervin
Collier Shannon Scott
3050 K Street, N.W.
Suite 400
Washington, D.C. 20007



Michelle Brownlee



Date

EXHIBIT A

Mailed:
April 12, 2005

**This Opinion Is Not
Citable as Precedent
of the TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Gillette Canada Company, dba Oral-B Laboratories
v.
Robin Research Laboratories, Inc.

Opposition No. 91124984
to application Serial No. 75662006
filed on March 17, 1999

Michelle Brownlee and Raymond J. De Vellis of The Gillette
Company for Gillette Canada Company.

Patrick J. Coyne and James M. Pacious of Collier Shannon
Scott for Robin Research Laboratories, Inc.

Before Walters, Bucher and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Robin Research Laboratories, Inc. [applicant] has
applied to register, on the Principal Register, the
following mark for goods identified as "electric toothbrush
and dental flossing units," in Class 21.

ORALMAX

Opposition No. 91124984

The application is based on applicant's claim of use of the mark in commerce and includes a statement explaining that the forms of lining in the mark represent, respectively, the colors blue and yellow.¹

Gillette Canada Company [opposer] has filed a notice of opposition seeking to prevent issuance of a registration to applicant. In its pleading, opposer has set forth a claim of ownership of seven federal registrations for the marks ORAL B or ORAL-B, the majority of them in certain stylized forms. Plain photocopies of the registrations were attached as exhibits to opposer's pleading. In addition to its assertion that it believes it will be damaged if applicant's mark is registered, opposer has pleaded a claim of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and a claim of dilution under Trademark Act Sections 2(f) and 43(c), 15 U.S.C. §§ 1052(f) and 1125(c).² Applicant, by its answer, admitted only opposer's allegation regarding the filing of applicant's application and what mark applicant seeks to register.

¹ Under current practice, applicant would have submitted a drawing of the mark showing the colors and a statement claiming colors as features of the mark. However, at the time this application was filed, various lining patterns were used to show where color appeared in a mark. See Trademark Rules 2.52 and 2.54, 37 C.F.R. §§ 2.52 and 2.54.

² Opposer has not referenced these sections of the statute, but its pleading is quite clear as to the claims it is asserting.

Opposition No. 91124984

On the last day of its main testimony period, opposer took the testimony deposition of Heather Gregg, a director in "the oral care division, Oral-B," of The Gillette Company. A transcript of the testimony and the exhibits introduced during the deposition were later filed for our consideration. On the penultimate day of the testimony period scheduled for rebuttal, opposer filed, by certificate of mailing, a notice of reliance on eight registrations. Applicant did not participate in the taking of testimony from opposer's sole witness and apparently did not introduce any evidence of its own, as there is none in the record.

Opposer filed a brief. Applicant did not. Neither party requested an oral hearing. We dismiss the opposition for opposer's failure to bear its burden of proof as plaintiff in this case.

Had opposer properly established, in any one of various ways, its ownership of, and the current status of, its pleaded registrations, that would have been sufficient to establish opposer's standing and to remove priority as an issue to be proved. See TBMP Section 704.03(b)(1)(A) (2d ed. rev. 2004), for an explanation of the various ways in which an opposer can ensure that its pleaded registrations are entered into or considered to be part of the record; see King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974), and Carl Karcher Enterprises

Opposition No. 91124984

Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125 (TTAB 1995), for the proposition that priority of use of a mark need not be proved when a pleaded registration for that mark is properly made of record.

Opposer's pleading did not make its registrations of record because the copies attached thereto are plain photocopies, not certified copies prepared by the USPTO showing status and title. Nor did the answer admit opposer's ownership of the registrations and their continuing validity.³ Thus, proper introduction of the registrations was a matter to be completed at trial.

Opposer's notice of reliance filed during the testimony period scheduled for rebuttal did not serve to place the registrations attached thereto into the record, because proof of ownership and status of the registrations is part of opposer's case in chief. Therefore, filing of the notice of reliance during rebuttal constitutes improper rebuttal.

Sprague Electric Company, Inc. v. Electrical Utilities Company, 209 USPQ 88, 93 and 95 (TTAB 1980), and Jacobsen Manufacturing Company v Automotive Associates, Inc., 149

³ Items attached to a pleading (with the exception of certified copies of registrations showing status and title) do not form part of the trial record in a Board inter partes proceeding, in the absence of an admission of their authenticity by the non-offering party in a responsive pleading, or by a stipulation of the parties, or by proper introduction during trial. See Trademark Rule 2.122(c) and (d), 37 C.F.R. §2.122(c) and (d); see also TBMP Sections 317, 704.05, 704.06 and 706 (2d ed. rev. 2004).

Opposition No. 91124984

USPQ 651, 652-53 (TTAB 1966) ("As to opposer's registrations of 'TURBOCONE' and 'TURBO-VAC', apart from any other consideration, they manifestly constitute improper matter for rebuttal."). See also, Jean Patou Inc. v. Theon Inc., 18 USPQ2d 1072, 1075 (TTAB 1990) (untimely notice of reliance on status and title copy of registration filed after close of testimony period).

Moreover, as applicant did not present any evidence during its assigned testimony period, there was no case in chief presented by applicant and nothing for opposer to rebut. Therefore, opposer actually had no right to file anything during its rebuttal testimony period. Accordingly, we have not considered opposer's notice of reliance.

As noted above, the TBMP outlines various ways for a plaintiff to make its pleaded registrations part of the record, including by appropriate testimony from a competent witness, and even notes ways in which a defendant may effectively have stipulated that the pleaded registrations are of record notwithstanding that a plaintiff has not properly introduced them. In this case, applicant has done nothing that can be considered an admission of the validity and ownership by opposer of the registrations. Nor has opposer's witness established her competency to testify as to ownership and status of the pleaded registrations. The witness did not testify as to the relationship between the

company for which she works, The Gillette Company, and opposer, Gillette Canada Company. In short, no foundation was laid to establish her personal knowledge of the status and title of registrations purportedly owned not by her employer but by another entity.⁴ Moreover, even if she had testified as to the relationship of the companies, she did not present any testimony whatsoever about the registrations.⁵

We have reviewed the deposition of opposer's witness to determine whether there is any testimony concerning use, as opposed to registration, of opposer's marks, and whether such testimony is sufficient to establish use by opposer prior to the filing date of applicant's application. We have found none. The testimony of the witness focuses primarily on sales and advertising figures, consumer recognition of opposer and its products, and opposer's

⁴ Ms. Gregg testified that she is employed by "The Gillette Company" and its "oral care division, Oral-B." In contrast, opposer is "Gillette Canada Company, dba Oral-B Laboratories." Opposer's brief (p. 1) states that The Gillette Company is opposer's parent company. Statements in a brief, however, are not evidence. See authorities collected in TBMP Section 704.06(b) n. 186 (2d ed. rev. 2004).

⁵ In contrast, in Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1770 (TTAB 1992), opposer presented stipulated testimony from the "Director of Trademarks of The Gillette Company" regarding the relationship between opposer and The Gillette Company, and the knowledge of the Director of Trademarks of registrations pleaded therein by opposer. Of course, each case requires its own record and the applicant in this case was not a party to the prior proceeding, so there is no preclusive effect in this case resulting from stipulated testimony or findings of fact in the prior case.

Opposition No. 91124984

market share vis a vis its competitors. There is no testimony of use of specific marks for particular products, as of any date prior to applicant's filing date.⁶ We note, in this regard, that opposer, in its brief, has cited to the dates of use in its oldest registration as evidence of its use long prior to applicant. However, dates of use recited in registrations are not evidence of use and are a matter for proof. See authorities discussed in TBMP Section 704.04 (2d ed. rev. 2004). Moreover, as noted above, opposer's registrations have not been made of record.

Because there is no evidence of use of opposer's pleaded marks prior to applicant's filing date, and because opposer did not remove the issue of priority by properly making its pleaded registrations of record, opposer's claim under Section 2(d) fails for lack of proof and is dismissed. See Lone Star Manufacturing Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974) (when an applicant does not prove use as of any particular date, it may only rely on the filing date of its application); see also, Intersat Corp. v. International Telecommunications Satellite Organization, 226 USPQ 154 n.5 (TTAB 1985).

⁶ There are discussions of products launched in the two or three years prior to the taking of the deposition in January 2004, and of sales figures for those years. There is even a passing reference to tracking studies measuring consumer awareness having been conducted as early as 2001. There is not, however, any testimony as to use of marks prior to March 17, 1999, i.e., applicant's filing date.

Opposition No. 91124984

Likewise, because there is no evidence of opposer's use prior to applicant's filing date, there can be no proof that opposer's marks became famous prior to applicant's filing date and, therefore, its dilution claim also fails for lack of proof and is dismissed. Toro Co. v. ToroHead Inc., 61 USPQ2d 1164, 1174-75 (TTAB 2001) (opposer pleading dilution must prove that its mark became famous prior to the filing date of an intent to use application).⁷

Decision: The opposition is dismissed as to both of opposer's claims.

⁷ At note 9 of the Toro decision, the Board wrote, "In a use-based application under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), the party alleging fame must show that the mark had become famous prior to the applicant's use of the mark." Solely for purposes of this case, which involves a use-based application, we assume that this statement from Toro applies when there is proof of applicant's actual use. We also assume that the issue of dilution should be treated the same as the issue of priority when there is no proof of an applicant's actual use prior to its filing date. Consequently, we assume that an opposer in such case would only have to prove the fame of its mark prior to the applicant's filing date.

EXHIBIT B

Opposition No. 91124984

**This Opinion is Not
Citable as Precedent
of the TTAB**

Mailed:
June 3, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Gillette Canada Company, dba Oral-B Laboratories
v.
Robin Research Laboratories, Inc.

Opposition No. 91124984
to application Serial No. 75662006
filed on March 17, 1999

On Request for Reconsideration

Michelle Brownlee and Raymond J. De Vellis of The Gillette
Company for Gillette Canada Company.

Patrick J. Coyne and James M. Pacious of Collier Shannon for
Robin Research Laboratories, Inc.

Before Walters, Bucher and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

On April 12, 2005, we dismissed opposer's opposition
for opposer's failure to bear its burden of proof in regard
to either of the claims it had asserted. Opposer has filed
a timely request for reconsideration. Applicant has filed a
brief in opposition to the request for reconsideration.

Opposition No. 91124984

In our decision, we explained why opposer's filing of a notice of reliance during its rebuttal testimony period was improper. Specifically, we noted that applicant had not presented any evidence during its assigned testimony period and there was not, therefore, anything for opposer to rebut; and we also noted that opposer's pleaded registrations, which were the items covered by its notice of reliance, were part of its case in chief, so that even if applicant had presented evidence, introduction of proof of opposer's case in chief during rebuttal would have been improper rebuttal.

Opposer, citing Trademark Rule 2.122(b)(2), 37 C.F.R. § 2.122(b)(2), now argues that the rule providing for introduction of status and title copies of a plaintiff's registrations by notice of reliance does not distinguish between filing them during a main testimony period or a rebuttal testimony period. We construe the argument as relying on Rule 2.122(d)(2), which is the correct rule covering such evidence. Nonetheless, we reject the argument. Just because the rule does not differentiate between a plaintiff's two testimony periods does not mean that a plaintiff may file whatever it wishes during its rebuttal testimony period. Adherence to such a proposition would eviscerate the distinction between evidence properly considered part of a plaintiff's case in chief and that which is properly introduced as rebuttal. We note, too,

Opposition No. 91124984

that Trademark Rule 2.121(b)(1) specifies that the Board will set "a testimony period for the plaintiff to present its case in chief, a testimony period for the defendant to present its case and to meet the case of the plaintiff, and a testimony period for the plaintiff to present evidence in rebuttal." Rule 2.122(d)(2) must be read in concert with this rule that precedes it, not in a vacuum.

An alternative argument why we should consider the notice of reliance, notwithstanding that it was improperly filed as rebuttal evidence when there was nothing to rebut, notes that applicant did not present any evidence of its own and did not object to plaintiff's filing; and we add, just to ensure that this argument is fully considered, that applicant neither objected to the notice of reliance when it was filed or in a brief (it did not file a brief). We also reject this alternative to opposer's first argument.

Though opposer has not discussed any authority in support of this argument, we note that there are decisions that hold that a party may be viewed as having waived certain objections, which might otherwise be raised against a notice of reliance, if the objections are not promptly raised. See authorities discussed in TBMP Section 707.02(a) (2d ed. rev. 2004). However, such objections are required when the party filing evidence improperly will have an opportunity to remedy its error. Opposer could not have

Opposition No. 91124984

remedied its error in this instance, because the error was not a technical or procedural deficiency but, rather, the filing of improper rebuttal evidence. As for applicant's failure to file a brief, an applicant is under no obligation to do so. See TBMP Section 801.02(b). We recognize that as a result of its inaction, applicant never objected to opposer's improper rebuttal evidence, but opposer had no right to presume that the Board would consider improperly adduced evidence. See Original Appalachian Artworks Inc. v. Streeter, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987) and TBMP Sections 702 and 706.

Opposer's final argument in its motion for reconsideration essentially seeks leave to introduce as evidence, testimony from another proceeding.¹ This is a manifestly untimely request, as such evidence must be offered "during the appropriate trial period." See TBMP Section 704.13.²

The request for reconsideration is denied.

¹ Opposer states in its motion that the testimony is from Opp. No. 91126804, which would be a proceeding commenced after the instant proceeding. But the attached transcript of the testimony reveals that it is actually from Opp. No. 91116804 and was taken prior to commencement of the instant proceeding.

² While opposer also addresses our observation in our decision dismissing the opposition that opposer's witness (not an employee or officer of opposer) did not lay a foundation for and establish her competency to testify about marks or registrations owned by opposer, we need not respond to this. Even if we were to infer, as opposer requests, that opposer and the employer of the witness are related companies, the fact remains that the witness did not testify about opposer's pleaded priority of use of its marks.